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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/799,941	03/11/2004	Martha G. Welch	5199-134	8041

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WilmerHale/Columbia University
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EXAMINER	
KOSAR, ANDREW D	

ART UNIT	PAPER NUMBER
1654	

MAIL DATE	DELIVERY MODE
05/29/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/799,941	WELCH ET AL.	
	Examiner	Art Unit	
	Andrew D. Kosar	1654	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *28 February 2007*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1,8-17,21 and 23* is/are pending in the application.

4a) Of the above claim(s) *9-16* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1,8,17 and 21* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *28 February 2007* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *2/28/07*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Response to Amendment/Arguments

Applicant's amendments and arguments filed February 28, 2007 are acknowledged and have been fully considered. Any rejection and/or objection not specifically addressed is herein withdrawn.

Applicant has amended the pharmaceutical composition to no longer recite an intended use, and thus meets the standards of enablement, as at least one use of the compound is enabled. Therefore the 35 USC § 112 1st ¶, enablement, rejection is withdrawn.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1, 8, 17 and 21 remain rejected under 35 U.S.C. 103(a) as being unpatentable over HOLLANDER in view of NIH News Alert, both presented *supra*, and in further view of SWAIN (E. Swain. Pharmaceutical and Medical Packaging News (1999) 4 pages) and PIERCE (PIERCE Technical Resource Sheet TR0043.0 "Protein Stability and Storage" 6/03, 3 pages), for the reasons of record and those set forth below.

The instant claims are drawn to compositions of OT/S, kits thereof, for a variety of intended uses, optionally with a protease inhibitor.

Applicant argues that "one of ordinary skill in the art would not refer to secretin as a chemical compound" (*Remarks*, page 13); that the combination therapy of Hollander are generic combinations and "does not [teach] or suggest a specific peptide or hormone, let alone secretin" and thus asserts that the examiner relies improperly on hindsight reasoning; that the combination teachings fail to teach "*a synergistic effect*".

Respectfully, the examiner disagrees. Secretin, while a peptide, is certainly considered 'a chemical compound' to a chemist, as it is made up of carbon, nitrogen, hydrogen and oxygen atoms, having the formula $C_{130}H_{220}N_{44}O_{41}$ and a Chemical Abstract Service Registry number of 1393-25-5. If it were not a chemical compound, it would not be present in such a database. Furthermore, Hollander need not teach specifically secretin for an obviousness rejection, as it appears Applicant is applying an improper standard of obviousness- requiring anticipation to prove obviousness, nor is it proper to require a strict "teaching, suggestion or motivation" to combine oxytocin and secretin to establish obviousness. Further *In re Kerkhoven* is applicable as it is the combination of two compounds useful for the same purpose- treating autism- which are combined to make a third composition for treating autism which would flow logically from the teachings in the art. Additionally, in response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., *synergistic effect*) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Hollander teaches treating autism with oxytocin (claim 1) and that, "Agents suitable for use in combination therapy are any chemical compound or treatment method useful to patients with disorders associated with repetitive behaviors..." (paragraph [0046]).

NIH News Alert teaches treating autism with secretin (e.g. page 2, citing Horvath, et al.).

Swain teaches that packaging of pharmaceuticals can add to the 'bottom line' by reducing theft, counterfeiting, increasing shelf life, and improve patient compliance (page 1 of 4).

PIERCE teaches that protease inhibitors are added to protein solutions to lengthen shelf life (e.g. Table 2, page 2) by preventing cleavage of proteins.

As set forth in *In re Kerkhoven*, 205 USPQ 1069 (CCPA 1980), "It is *prima facie* obvious to combine two compositions each of which is taught by prior art to be useful for same purpose in order to form third composition that is to be used for very same purpose; the idea of combining them flows logically from their having been individually taught in prior art." Thus, because both oxytocin and secretin have been taught in the prior art as useful for treating autism, it would have been obvious to have combined the two for making a composition for the same purpose.

With regards to the kit, the examiner has interpreted 'kit' broadly to include packaging for sale. It would have been obvious at the time of the invention to have packaged the

pharmaceutical composition in any packaging for the benefit of reducing theft, reducing counterfeiting and increasing shelf life of the compound, as well as for the benefit of product recognition during sales of the product. One would have been motivated to have packaged the pharmaceutical for the benefit of, but not limited to, increasing shelf life of the compound and to increase the product visibility. One would have had a reasonable expectation for success in packaging the pharmaceutical in order to prolong the shelf life, as packaging pharmaceuticals is widely practiced in the formulary arts in order to generate sales.

Furthermore, it would have been obvious to have added into the composition and/or kit a protease inhibitor to prevent protein degradation/cleavage during storage to increase the shelf life. One would have been motivated to have added a protease inhibitor to the composition/kit because oxytocin and secretin are both peptide compounds, susceptible to proteolysis, and to increase the shelf life of the peptides in the composition. One would have had a reasonable expectation for success in making the composition/kit with a protease inhibitor as PIERCE teaches protease inhibitors are added to prevent proteolytic cleavage of peptides during storage and to increase the shelf life.

From the teachings of the references, it is apparent that one of ordinary skill in the art would have had a reasonable expectation of success in producing the claimed invention. Therefore, the invention as a whole was *prima facie* obvious to one of ordinary skill in the art at the time the invention was made, as evidenced by the references, especially in the absence of evidence to the contrary.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

This application contains claims 9-16 and 23 drawn to an invention nonelected without traverse in the reply filed on August 15, 2005 and February 14, 2006. A complete reply to the final rejection must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Andrew D. Kosar whose telephone number is (571)272-0913. The examiner can normally be reached on Monday - Friday 08:00 - 16:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cecilia J. Tsang can be reached on (571)272-0562. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/adk/
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